

REMARKS

The Office Action dated September 21, 2006, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment claim 7 has been added. No new matter is presented. Support for claim 7 can be found in at least page 3, lines 3-4 of the Specification as originally filed. Claim 6 has been allowed. Accordingly, claims 1-5 and 7 are pending and respectfully submitted for consideration.

Allowable Subject Matter

The Applicants wish to thank the Examiner for allowing claim 6.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 4 and 5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Walton et al. (U.S. Patent No. 5,355,144, "Walton"). Claims 2, 4 and 5 depend from claim 1. The Applicants traverse the rejection and respectfully submit that claims 1, 2, 4 and 5 recite subject matter that is neither disclosed nor suggested by Walton.

Claim 1 recites an on-board antenna comprising a radiation element provided on a dielectric substrate, a grounding conductor provided on the dielectric substrate and surrounding a periphery of an outer edge portion of the radiation element at a position spaced away outwardly from the outer edge portion. A conductive member is provided on the dielectric substrate at a position spaced away outwardly from an outer edge portion of the grounding conductor. The radiation element, the grounding conductor, and the conductive member are provided on the same surface of the dielectric substrate.

Walton discloses an automobile 10 having a windshield 12. Immediately below the windshield 12 is a conductive auto body panel 14, such as a hood, extending generally horizontally from below the window 12. The window 12 is surrounded by a metal frame, which may be a separately identifiable bezel. The window appears electrically as a metal sheet 18 having an inner metal edge 20 defining an aperture. The aperture is closed by a non-conductive optically transparent window 12, typically of glass, extending across the aperture. An electrically conducting, optically transparent film panel 16 is bonded to the window and has an outer peripheral film edge 22 which is spaced from the inner metal edge 20 to define a polygonal antenna slot 24 between the edge 20 and the film edge 22. See column 3, line 58 to column 4, line 11 of Walton.

With respect to claim 1, the Applicants respectfully submit that Walton fails to disclose or suggest the claimed features of the invention. As discussed above, claim 1 recites a grounding conductor provided on the dielectric substrate (emphasis added). The Office Action took the position that the metal sheet 18 was comparable to the grounding conductor and the window 12 was comparable to the dielectric substrate. However, there is no disclosure or suggestion in Walton that the metal sheet 18 is provided on the windshield 12. In contrast, Walton discloses that the metal sheet has an inner metal edge 20 defining an aperture and that the aperture is closed by a non-conductive optically transparent window 12. As such, there is no disclosure or suggestion in Walton that the metal sheet 18 is provided on the window 12.

Claim 1 further recites a conductive member provided on the dielectric substrate and that the radiation element, the grounding conductor, and the conductive member are provided on the same surface of the dielectric substrate (emphasis added). The

Office Action took the position that the auto body panel 14 of Walton, shown as a hood, was comparable to the conductive member. See page 2, line 17 of the Office Action. However, there is no disclosure or suggestion in Walton that the hood 14 is provided on the window 12. In contrast, Walton discloses that the hood 14 extends generally horizontally from below the window 12. See column 3, lines 61-62 of Walton. As shown in Fig. 1 and Fig. 2 of Walton, the hood 14 is not provided on the windshield 12. As such, there is no disclosure or suggestion that the hood 14 in Walton is provided on the same surface of the window as the metal sheets 18 and the antenna slot 24. Therefore, Walton fails to disclose or suggest at least the combination of features of a grounding conductor provided on the dielectric substrate and a conductive member provided on the dielectric substrate and that the radiation element, the grounding conductor, and the conductive member are provided on the same surface of the dielectric substrate, as recited in claim 1.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicants respectfully submit that Walton does not disclose or suggest the features of the invention as recited in claim 1. Accordingly, Walton does

not anticipate claim 1, nor is claim 1 obvious in view of Walton. As such, the Applicants submit that claim 1 is allowable over Walton. Claims 2-5 depend from claim 1 and are allowable for at least the same reasons.

Rejection Under 35 U.S.C. § 103

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Walton in view of Harada (U.S. Patent No. 5,124,714). Walton was cited for disclosing many of the claimed elements of the invention with the exception of the conductive member being of a circular shape. Harada was cited for curing this deficiency.

Harada discloses a dual slot planar mobile antenna fed with coaxial cables in which a first closed-circle slot 21 is provided between a peripheral conductor or peripheral conducting surface 10 and a first central conductor or first central conducting surface 11, and a second closed-circle slot 22 is provided between the first central conductor 11 and the second central conductor or second central conducting surface 12. See column 2, lines 12-18 of Harada.

Claim 3 depends from claim 1. As discussed above, Walton does not disclose or suggest the features of the invention as recited in claim 1. The Applicants respectfully submit that Harada fails to cure the deficiencies in Walton with respect to claim 1, as Harada also does not disclose the grounding conductor provided on the dielectric substrate and a conductive member provided on the dielectric substrate wherein the radiation element, the grounding conductor and the conductive member are provided on the same surface of the dielectric substrate, as recited in claim 1. Therefore, the combination of Walton and Harada fails to disclose or suggest the features of the invention as recited in claim 1, and therefore, dependent claim 3.

In view of the above, the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claim 3 under 35 U.S.C. § 103.

Conclusion

The Applicants respectfully submit that claims 1-5 and 7 are allowable. Claims 2-5 and 7 depend from claim 1. The Applicants further submit that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above. Accordingly, the Applicants respectfully request withdrawal of the rejections, allowance of claims 1-5 and 7 and the prompt issuance of a Notice of Allowability.

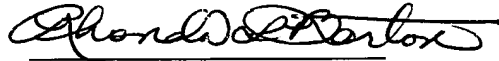
Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper,

may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt.**

No. 107355-00100.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rhonda L. Barton", written over a horizontal line.

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